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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,791	10/29/2003	Reinhard Deutsch	41653-197865	6085

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EXAMINER

PURVIS, SUE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,791

Applicant(s)

DEUTSCH ET AL.

Examiner

Sue A. Purvis

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 23-30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by German Patent No. 27 02 482 (hereafter DE '482).

Regarding claim 23, DE '482 discloses a unit for applying labels or coupons¹ to packets. The device in DE '482 includes:

- a. A feed means by which the labels (11) are obtained as cuts from a continuous strip (12)²;
- b. An assembly station (5) with a pocket (6); and
- c. A pick up and transfer unit (14) which takes the label (11) from the feed means and conveys it to a release position at the assembly station.³

3. Claims 23 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Glösmann (US Patent No. 4,198,258).

¹ "Inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims." *In re Young*, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in *In re Otto*, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963)). Therefore the fact that DE '482 feeds a label instead of a "coupon" does not differentiate it from applicant's invention. "Coupon" is considered to be material worked upon.

² It should be noted applicant uses alternative language and the device of claim 23 need either a first or a second feed means, both are not required to anticipate the claim.

³ The language of claim 23, in particular "where the coupon is placed in a desired position relative to the pocket of the assembly station prior to insertion of the coupon into a packet," is considered functional language. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). Here, DE '482 teaches all the structural features of claim 23 as detailed above.

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Regarding claim 23, Glösmann discloses an apparatus for applying labels⁴ (4) to cigarette packs. The device in Glösmann includes:

- a. A feed means by which the labels (4) are obtained as single items ordered in a stack (6);
- b. An assembly station (48) with a pocket; and
- c. A pick up and transfer unit (7) which takes the label (4) from the feed means and conveys it to a release position.⁵

Regarding claim 25, the feed stack in Glösmann comprises a magazine.

4. Claim 23 and 27-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffman (US Patent No. 3,834,963).

Regarding claim 23, Hoffman discloses a unit for applying labels or coupons to packets. The device in Hoffman includes:

- a. A feed means by which the labels (56) are obtained as cuts from a continuous strip (12);
- b. An assembly station (96) with a pocket (102); and
- c. A pick up and transfer unit (151) which takes the label (56) from the feed means and conveys it to a release position at the assembly station.

Regarding claims 27 and 28, the pick up and application device (151) moves between the pick up station and the release position about an axis and rolls tangentially during the step of picking up the label and passing it to a release position. (See Figure 2.)

Regarding claim 29, the vacuum drum (151) in Hoffman includes suction holes equivalent to applicant's suction cups enabling the label (56) to be held thereon.

⁴ The fact that Glösmann feeds a label instead of a "coupon" does not differentiate it from applicant's invention. "Coupon" is considered to be material worked upon.

⁵ A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

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Regarding claim 30, the drum (151) includes radial projections (173) and grooves (174) which are first and second guiding and locating means which ensure the correct transfer of the labels (56). (Col. 6, lines 49-69.)

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glösmann in view of Bright (EP 0 370 633 A1).

Regarding claim 24, Glösmann does not disclose a first and second feed means which are mutually interchangeable.

Bright discloses a unit for applying labels to packets with first means by which the labels are procured as single items ordered in a stack (Figure 2) or a second means by which to feed slips obtainable as cuts made from a continuous strip (Figures 2 and 3), and a universal pickup and application device (19) installed permanently in the machine such as will take up the slips with equal facility from either the first or the second feed means. Bright teaches there can be a need to change labeling operation from one type of a machine to another and that having a machine which is readily and quickly changed is preferable to using different machines. (Col. 2, lines 9-39.)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a feed means which feeds labels from a strip which can replace the feed of Glösmann, because Bright teaches the advantages of such a system.

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Regarding claim 26, the second feed means comprise a means which respectively decoil, feed and cut a continuous strip to index the strip as shown in Bright.

Response to Arguments


4. Applicant's arguments with respect to claims 23-30 have been considered but are moot in view of the new grounds of rejection.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sue A. Purvis
Primary Examiner
Art Unit 1734

SP
August 15, 2005